

Appl No. 09/575,129
Amdt. Dated August 16, 2005
Response to Office Action of June 30, 2005

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REMARKS/ARGUMENTS

The Office Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Office Action.

The Examiner has rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over Dymetman (USPN 6,330,976) in view of Berson *et al.* (USPN 6,039,257).

The Applicant respectfully submits that there is no suggestion or motivation, either in the above-cited references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings to achieve the result claimed in claim 1.

In particular, Dymetman is directed towards coding a substrate with encoded identifiers for causing an action through a network (see abstract). In contrast, Berson is concerned with teaching a system "that scans and reads IBI in accordance with the United States Postal Service Specification" (see abstract).

Additionally, Dymetman describes a method by which a coded substrate supplier produces machine-readable markings, that is, invisible markings on sheets of paper and a publisher will then buy these sheets of paper and print visible markings on them using standard ink, prior to the user then using these sheets of paper (see column 11 lines 46 to 65). Hence, two separate entities, that is the supplier and the publisher, are required by Dymetman in order to produce a substrate with visible and invisible markings.

However, Berson describes an apparatus that uses a postage meter that prints an IBI, scans and checks the IBI and prints an invisible message over the IBI (see column 2, lines 17 to 24). Thus, Berson does not require the use of a separate supplier and publisher. Hence, there would be no motivation for a person skilled in the art to modify the teachings of Dymetman with the teachings of Berson as Dymetman and Berson are solving two distinct problems.

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Furthermore, as Dymetman distinctly states that two separate printing entities are required, then by modifying Dymetman with the teaching of Berson, the proposed modification would render the Dymetman invention unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to make the proposed modification (see MPEP 2143.01, in reference to *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Therefore as stated in MPEP (see MPEP 2143.01, in reference to *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)):

"if the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious"

Thus, by combining Dymetman and Berson, as the principle of operation of Dymetman has to be modified, the combination is insufficient in rendering the claims prima facie obvious.

In any event, claim 1 of the present application has been amended such that the visible information and the invisible coded data are printed substantially simultaneously by a printer.

A basis for this amendment can be found on page 26, lines 1 to 12, which describes the netpage printer receiving *"subscribed netpage documents from netpage publication servers 14. Each document is distributed in two parts: the page layouts, and the actual text and image objects which populate the pages. Because of personalization, page layouts are typically specific to a particular subscriber and so are pointcast to the subscriber's printer via the appropriate page server. Text and image objects, on the other hand, are typically shared with other subscribers, and so are multicast to all subscribers' printers and the appropriate page servers. The netpage publication server optimizes the segmentation of document content into pointcasts and multicasts. After receiving the pointcast of a document's page layouts, the printer knows which multicasts, if any, to listen to. Once the printer has received the complete page layouts and objects that define the document to be printed, it can print the document"*.

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Thus, the same printer prints the page layouts and the objects, that is, the invisible coded data and the visible content respectively. Hence, the invisible coded data and the visible content are printed substantially simultaneously.

The Applicant respectfully submits that, as none of the prior art documents show the ability to print the visible information and the invisible coded data substantially simultaneously, claim 1 is non-obvious.

Similar amendments have also been made to independent claims 4, 82, and 86, and similar arguments apply.

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CONCLUSION

In light of the above, it is respectfully submitted that the objections and claim rejections have been successfully traversed and addressed. The amendments do not involve adding any information that was not already disclosed in the specification, and therefore no new matter is added. Accordingly, it is respectfully submitted that the claims 1 to 180, and the application as a whole with these claims, are allowable, and a favourable reconsideration is therefore earnestly solicited.

Very respectfully,

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